

08-26-04

04/392,925 AC

Docket No. 08-045

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Refusal to Record Order Against :
U.S. Patent Nos. 6,359,188, :
6,302,026, 5,728,967, and :
5,719,350 :

Petitioner: Cintec International Ltd. :

RECEIVED
SEP / 2 2004
TC 1700

PETITION UNDER 37 CFR 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Cintec International, Ltd., by the undersigned counsel, hereby respectfully petitions the Commissioner for Patents to record the Order attached as *Exhibit A* against U.S. Patent Nos. 6,359,188, 6,302,026, 5,728,967, and 5,719,350 (hereinafter "the U.S. Patents").

STATEMENT OF THE FACTS

Petitioner Cintec International Ltd. secured a judgment of non-infringement of certain UK Patents owned by John Humphries Parkes, a British subject who was found by the Honorable Justice Hugh Laddie of the English High Court of Justice ("the Court") to have made unjustified threats of infringement. Consequently, Justice Laddie made an award of costs to Petitioner in the amount of approximately £185,000 representing its expenses in bringing the action. Mr. Parkes did not satisfy the award in a timely fashion.

Upon learning of possible intention to transfer an interest in the patents, Petitioner applied to the Court for an injunction freezing Mr. Parkes assets. Such resulted in the

issuance of the aforementioned Order on or about February 5, 2004. This Order prohibits Mr. Parkes from “in any way” disposing of his assets, which are specifically enumerated as including “all UK, US and other patents held” in his name (see Order, paras. 5-7(b)).

In concurrently pending U.S. litigation, Petitioner seeks *inter alia* a Declaratory Judgment of Non-Infringement of certain of the U.S. Patents owned by Mr. Parkes (see Complaint, *Exhibit B*). In response, Mr. Parkes admits having an ownership interest in the U.S. Patents (see Answer and Motion to Dismiss documents attached as *Exhibit C*), and in fact has made a counterclaim of infringement based on them (*id.*).

On August 18, 2004, Petitioner requested recordation of the Order attached as *Exhibit A* against the U.S. Patents so that any person performing a title search would be placed on notice of the prohibition against transfer of Mr. Parkes’ ownership interest (copy of electronically generated recordation cover sheet attached as *Exhibit D*). On that same date, the request was denied by Examiner Joann Stewart of the Assignment Division of the U.S. Patent & Trademark Office. Two reasons are cited for refusing to record the Order: (1) the cover sheet is allegedly unacceptable because it omits the name and address of the receiving party; (2) the cover sheet is allegedly unacceptable because it omits the name and address of the conveying party (see *Exhibit E*). Since the document for which recordation is sought is an Order, no conveying and receiving parties are listed, which thus prevents Petitioner from completing the form in the manner required by Examiner Stewart.

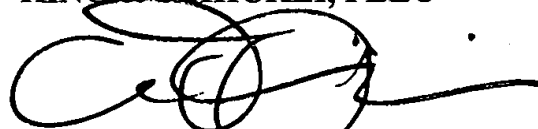
ACTION REQUESTED

Petitioner hereby craves the Honorable Commissioner of Patents to reverse Examiner Stewart's decision and record the above-mentioned Order against the U.S. Patents. Section 313 of the Manual of Patent Examining Procedure provides that "documents not affecting title [to a patent] may be recorded" and recognizes the discretion of the Commissioner in this regard. Recordation of the Order is justified here because it will place the public on notice that Mr. Parkes' interests in the subject U.S. Patents are the subject of a Freezing Order, thus preserving assets in which Petitioner may ultimately be determined to have an interest. In this regard, it is further noted that the Freezing Order has been accepted for recordation by the UK Patent Office for certain UK counterparts to the U.S. Patents (see *Exhibit F*). Accordingly, recordation of the Order is proper, despite Petitioner's inability to present a cover sheet including the information required by 37 CFR 3.31 and insisted upon by Examiner Stewart.

In light of the foregoing, Petitioner respectfully requests that its petition be granted. In the event some fee is due, the Commissioner may debit it from Deposit Account 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read "Andrew D. Dorisio", is written over the printed name and registration number.

Andrew D. Dorisio
Registration No. 41,713

247 North Broadway
Lexington, KY 40507
(859) 252-0889

CERTIFICATE OF MAILING

I hereby certify that this correspondence
is being deposited with the United States Postal
Service as Express Mail #EV212284787U9
addressed to: Commissioner for Patents, P.O. Box 1450
Arlington, VA 22313-1450, on August 25, 2004

Date

8/25/04 [Signature]